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REMARKS

Claims 1-15 and 24-26 are pending upon entry of the above amendment. Restricted out claims 16-23 are canceled. Reconsideration is respectfully requested for the following reasons.

In response to the previous election, Applicant confirms the election of Figs. 2-7. Claims 1-15 (as well as new claims 24-26) read on the elected embodiment, and at least claims 1-5 are generic.

In response to the further restriction in the recent Office Action, Applicant elects Species 1 (Fig. 9). Claims 1-15 and also new claims 24-26 read on the elected species.

The objection to the drawings is now moot due to the amended paragraph [0020] which affirmatively states that the "inner member 11" is "also called a 'slide member' herein") and the "extension 20" is "also called a 'plunger' herein." Applicant appreciates and acknowledges that the Examiner proceeded to examine the claims on this basis. It is noted that the claims are also clarified.

Claims 6-15 were rejected for being indefinite. These claims are now clear and definite for the following reasons. Claim 6 uses the word "plunger," which is now clearly identified by the amendment to paragraph [0020] discussed above. The structure of claim 6 is found in the disclosed embodiment as follows: the pneumatic mechanism includes a cylindrical chamber (formed by sidewall 29 in cavity 14, Fig. 4, paragraph [0020]) in the knob (9) and a plunger (20), at least a first end portion (i.e., the RH end 28 with annular groove 21) of which is slidably disposed in the cylindrical chamber (29), the annular groove (21) located adjacent the first end portion of the plunger. Also, in claim 8, the slot is item (23), and the resilient ring is item (30) which moves to close off the passageway as the plunger is moved outwardly (toward the left in Fig. 4), and permits fluid flow through the passageway as the plunger is moved inwardly (toward the right in Fig. 4). Claim 13 is amended to define a slide member (11), with the plunger (20) extending axially from the slide member (11).

Claim 15 was rejected as being indefinite. Claim 15 has been amended to define the second cavity as being elongated and defining a longitudinal axis . . . such that it is now clear and definite.

Claims 1-9 were rejected as being unpatentable over Muramatsu 4,919,242 in view of

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Hiramoto 5,697,477, and claims 10-15 were rejected as being unpatentable over Osborn 5,494,141 in view of Hiramoto 5,697,477. These rejections are respectfully traversed for the following reasons.

Hiramoto 5,697,477 is believed to be non-analogous art, and accordingly should not be cited against the present claims. To determine whether a reference is analogous, two criteria are used: 1) whether the art is from the same field of endeavor, regardless of the problem addressed, and 2) if the reference is from a different field of endeavor, whether it still is reasonably pertinent to the particular problems with which the inventor is involved. *In re Clay*, 966 F2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992).

In the recent Office Action, Hiramoto is cited for disclosing an air dampener combinable with other prior art showing a shifter mechanism. The Examiner took the position that Hiramoto in column 1, lines 55-63 discloses that it is “for the purpose of obtaining satisfactory damping by coping with a change in the load by changing the damping force (col. 2, lines 3-5). However, Hiramoto is from a different field of endeavor since it concerns a glove box door, and has nothing to do with shifter mechanisms (as defined in the claims). Therefore, Hiramoto does not satisfy the first criteria noted above.

Further, Hiramoto is solving a different problem, and therefore does not meet the requirements of the second part of the test for analogous art. Specifically, Hiramoto discloses an air dampener designed “so as to gradually increase a frictional force between an inner periphery of the reduced-diameter portion and the sealing member.” (See the last three lines of the abstract in Hiramoto, and also see Fig. 5.) The reason for this teaching is so that the glove box door in Hirzmatu receives increasing dampening as an effective weight of the door increases as the door is opened (due to effects of gravity and a changing center of gravity relative to its pivot axis). However, the shifter mechanism (and its components) do not exhibit any such change in gravitational effect. There is no reason to provide a variable dampening force in the shifter mechanism of claim 1 as taught in Hiramoto. Further, the present claim does not require a variable frictional force . . . nor any force to resist gravitation. Further, Hiramoto is not concerned with noise reduction, which is an important aspect in the present invention of claim 1.

In addition, Hiramoto does not meet the second part of the test for being analogous art, because it discloses his air dampener as being positioned exterior to his glove box in a location where there are no size constraints. Shifter mechanisms are used in highly visible and spacially-constrained locations, such as on a console between vehicle seats or on a shifter column next to a steering wheel. Though the claim 1 does not recite a particular size or location per se, the point is still a valid one . . . that it is non-obvious to cite prior art from an area where there are minimal spacial constraints . . . and to cite the art against a claim of a shifter mechanism where there are considerable spacial constraints.

Thus, the second criteria is also not satisfied since Hiramoto is solving of a different problem (i.e., both because of teaching a variable dampening force required for increasing weight as a glove box door opens, and also because of teaching a configuration where spacial constraints are significantly less of a problem).

Thus, Hiramoto is non-analogous and the Examiner is requested to withdraw any rejections based in part on Hiramoto.

The Examiner has also failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. § 706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As noted above, there must first be some suggestion or motivation to modify the reference or to combine reference teachings. Aside from the arguments of the non-analogous nature of Hiramoto, the Examiner has not sufficiently cited a motivation to combine the references. Muramatsu does not disclose or suggest any pneumatic device, nor a need for one, nor any reason to include one. Hiramoto concerns a glove box door that falls open with increasing force and requires increased dampening as it opens. There is no mention or suggestion of why a dampening mechanism as disclosed in Hiramoto would be needed in the shifter of Muramatsu . .

. nor would be needed in any shifter. Certainly, Hiramoto doesn't teach this, since his teaching is based on a door falling open by gravity and requiring increased dampening. Certainly Muramatsu doesn't teach this, since he did not include anything to dampen movement of his shifter button . . . nor indicate there was any need for it.

Secondly, there must be a reasonable expectation of success. If a glove box door (such as disclosed in Hiramoto) hangs up and does not open, this is not a safety problem. In fact, Hiramoto talks about the risk of a glove box door not opening as being a potential problem (see column 1, lines 64-67). Thus, Hiramoto can be interpreted as teaching against using the air dampener of Hiramoto in the environment of Muramatsu.

Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. For example, the Examiner's attention is directed to dependent claim 4 which recites a depressible button to motivate a movable member to selectively restrict movement of fluid (e.g., air). Further, see claims 24-26 which position the pneumatic mechanism within a shifter knob (see claims 24 and 26) or within a structural tubular member of a shift lever (see claims 25 and 26). These are not shown or suggested in either reference, as presently claimed.

In regard to claims 10-15, the same arguments apply as noted above. Specifically, Hiramoto is non-analogous, and any rejection based on Hiramoto should be withdrawn. Further, Osborn (like Muramatsu) teaches a shifter, but does not add any teaching or suggestion of a pneumatic mechanism. Still further, there are reasons to NOT modify Osborn to incorporate the structure of Hiramoto . . . for the same reasons as listed above for combining Muramatsu and Hiramoto.

Specifically, there is no suggestion or motivation to modify the reference or to combine reference teachings. Aside from the arguments of the non-analogous nature of Hiramoto, the Examiner has not sufficiently cited a motivation to combine the references. Osborn does not disclose or suggest any pneumatic device, nor a need for one, nor any reason to include one. Hiramoto concerns a glove box door that falls open with increasing force and requires increased dampening as it opens. There is no mention or suggestion of why a dampening mechanism as disclosed in Hiramoto would be needed in the shifter of Osborn . . . nor would be needed in any shifter. Certainly, Hiramoto doesn't teach this, since his teaching is based on a door falling open

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by gravity and requiring increased dampening. Certainly Osborn doesn't teach this, since he did not include anything to dampen movement of his shifter button.

Secondly, there must be a reasonable expectation of success. If a glove box door (such as disclosed in Hiramoto) hangs up and does not open, this is not a safety problem. In fact, Hiramoto talks about the risk of a glove box door not opening as being a potential problem (see column 1, lines 64-67). This teaches against using the air dampener of Hiramoto in the environment of Osborn.

Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. For example, the Examiner's attention is directed to claims 24-26 which position the pneumatic mechanism within a shifter knob (see claims 24 and 26) or within a structural tubular member of a shift lever (see claims 25 and 26) or that define spaced apart extensions (see claim 14). Notably, claim 24 positions the plunger in a location and orientation not taught or suggested by Muramatsu, Osborn, or Hiramoto.

For all of the above reasons, claims 1-15 and 24-26 are believed to be in condition for allowance, and a Notice of Allowability is earnestly solicited.

Respectfully submitted,

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